

## **REMARKS**

The Office Action dated February 29, 2008 ("Office Action") and cited references have been considered. Claims 1-40, 42-73 and 75-99 are currently pending. No amendments are being made in this paper. Reconsideration and allowance are respectfully requested.

Applicants wish to thank Examiner Maples for providing an opportunity to discuss the application in a telephone interview conducted on April 24, 2008.

### **1. Double Patenting**

In paragraphs 1-2 of the Office Action, claims 1-40, 43-73 and 75-99 were provisionally rejected for obviousness-type double patenting as being unpatentable over claims 13-36 of copending U.S. Application No. 11/129,760. During the Examiner Interview, the Examiner raised the question as to whether a terminal disclaimer was necessary in both the present application (09/954,526) and in copending U.S. Application No. 11/129,760. Applicants respectfully submit that according to MPEP § 1490, only one terminal disclaimer is required:

If the ODP rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer.

MPEP § 1490(V.)(D.). Applicants filed a terminal disclaimer in copending U.S. Application No. 11/129,760 on April 29, 2008. Therefore, it is believed that a terminal disclaimer is not necessary in the present application. Accordingly, reconsideration and withdrawal of the provisional obviousness-type double patenting rejection is respectfully requested.

### **2. Rejection Under 35 U.S.C. § 102(a)**

In paragraph 4 of the Office Action, claims 1, 2, 4-11, 13-19, 21-27, 29-33, 35-40, 42, 43, 47-58, 61-70, and 81-98 were rejected under 35 U.S.C. § 102(a) as being anticipated by German reference 9319361 ("the German '361 reference"). During the Examiner Interview, the Examiner indicated that Applicants' Declaration of Prior Invention Under 37 C.F.R. § 1.131 filed February 28, 2008 was proper and complete to predate the German '361 reference. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

### **3. Rejections Under 35 U.S.C. § 112, ¶ 2**

In paragraph 7 of the Office Action, claims 3, 12, 20, 28 and 34 were rejected under 35 U.S.C. § 112, ¶ 2 for indefiniteness. During the Examiner Interview, Applicants indicated that

an amendment would be filed to overcome this rejection. However, upon further consideration, Applicants respectfully submit that the claims do not need to be amended because they satisfy § 112, ¶ 2 in their current form. The standard for satisfying § 112, ¶ 2 is as follows:

Determining whether a claim is definite requires an analysis of “whether one skilled in the art would understand the bounds of the claim when read in light of the specification . . . If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more.”

*Personalized Media Communications LLC v. ITC*, 48 USPQ2d 1880, 1888 (Fed. Cir. 1998) (quoting *Miles Lab., Inc. v. Shandon, Inc.*, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993)).

Applicants respectfully submit that the phrase “a second end adapted to abut a support shoulder,” when read in light of the specification, would reasonably apprise those skilled in the art of the scope of the invention. In this regard, the specification of the original U.S. Patent No. 5,792,573 at col. 10, line 66 - col. 11, line 19 and Figure 24 shows a clear example of this structure that would be easily understood by one skilled in the art.

Applicants also refer the Examiner to a number of cases in which the language “adapted to” has been held to satisfy § 112, ¶ 2. *See, e.g., In re Venezia*, 189 USPQ 149 (CCPA 1976) (analyzing a claim with “adapted to” language and finding that it satisfied § 112, ¶ 2; and stating: “We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly.”); *Central Admixture Pharmacy Services, Inc. v. Advanced Cardiac Solutions P.C.*, 82 USPQ2d 1293 (Fed. Cir. 2007) (“[The defendant] suggests that the patent’s claim 13 and its dependent claims are invalid for indefiniteness, since they describe a solution that is ‘adapted to be diluted.’ We do not read that phrase as possessing any significant ambiguity, much less intractable ambiguity making the claim ‘not amenable to construction,’ which is the requirement to demonstrate indefiniteness.”); *Foremost In Packaging Systems, Inc. v. Cold Chain Technologies, Inc.*, 82 USPQ2d 1606 (interpreting the scope of claim with “adapted to” language without objection to that phrase).

Finally, Applicants note that claims 3 and 12 were issued in their current form in the original U.S. Patent No. 5,792,573, which indicates that they satisfied then, and therefore still satisfy, 35 U.S.C. § 112, ¶ 2.

For all of the foregoing reasons, Applicants respectfully submit that claims 3, 12, 20, 28 and 34 comply with 35 U.S.C. § 112, ¶ 2. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

**4. Objection Under 37 C.F.R. § 1.75(c)**

In paragraph 8 of the Office Action, claims 72, 73 and 75-79 were objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form. During the Examiner Interview, the Examiner explained that generally a dependent claim should not depend from a higher numbered claim, hence the objection to claims 72 and 73 that depend directly from claim 99, and the objection to claims 75-79 that depend indirectly from claim 99. Applicants indicated that an amendment would be filed to address this objection. However, upon further consideration, Applicants respectfully submit that the claims do not need to be amended. In particular, Applicants are not aware of any rule or requirement that dependent claims must have a higher number than the claim from which they depend. In fact, the MPEP acknowledges that a dependent claim in a reissue application may have a lower number than the claim from which it depends. *See* MPEP § 1455 (“No renumbering of the original patent claims is permitted, even if the dependency of a dependent patent claim is changed by reissue so that it is to be dependent on a subsequent higher numbered claim.”). Applicants respectfully submit, therefore, that claims 72, 73 and 75-79 are in a proper format. Accordingly, reconsideration and withdrawal of this objection is respectfully requested.

**5. Interview Summary**

Pursuant to MPEP § 713.04, Applicants provide the following information corresponding to subsections (A) - (H) of MPEP § 713.04.

(A) Exhibit. Not applicable.

(B) Claims Discussed. Applicants generally discussed the claims of record. Applicants discussed claims 3, 12, 20, 28, and 34 in connection with the rejection under 35 U.S.C. § 112, ¶ 2. Applicants discussed claims 72, 73 and 75-79 in connection with the objection under 37 C.F.R. § 1.75(c).

(C) Prior Art. Applicants referenced German reference 9319361.

(D) Proposed Amendments. See discussion above in sections 3 and 4.

(E) Arguments. As the Examiner indicated that the Declaration of Prior Invention Under 37 C.F.R. § 1.131 filed February 28, 2008 was acceptable, no arguments were presented.

(F) Other Pertinent Matters. See discussion above in section 1 regarding the necessity of filing a terminal disclaimer to overcome the obviousness-type double patenting rejection.

(G) Results or Outcome of Interview. The Examiner indicated that Applicants' Declaration of Prior Invention Under 37 C.F.R. § 1.131 filed February 28, 2008 was proper and complete to predate the German '361 reference.

(H) Interview by Electronic Mail. Not applicable.

## **6. Conclusion**


Having addressed all of the outstanding rejections of record, Applicants respectfully submit that the present application is in condition for allowance and notice to that effect is earnestly solicited. If there are any questions regarding this Request for Reconsideration or the application in general, the Examiner is encouraged to contact the undersigned at the telephone number below to expedite prosecution.

It is believed that no fees are due with the filing of this paper. However, in the event that any fees are due, please charge such fees, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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